

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent Application:

Inventor(s): Ackerman et al.

Group: 1625

Serial No. 09/925,188, filed August 9, 2001

Examiner: B. Robinson

For: 2,3-OXIDOSQUALENE-LANOSTEROL CYCLASE INHIBITORS

COMMUNICATION

Nutley, New Jersey 07110
May 5, 2003

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Communication is filed in response to the February 24, 2003 Office Action issued in connection with the above-identified patent application. A response to this Office Action was originally due March 24, 2003. A two-month extension of time is being requested concurrently. Accordingly, a response is now due May 24, 2003.

In the Office Action, a four-way restriction requirement was made under 35 U.S.C. § 121, as was the requirement to elect a single species for examination purposes. The four groups suggested by the Patent Office do not encompass all of the compounds falling within the scope of claim 1. Accordingly, the undersigned attorney telephoned the Examiner to discuss this matter, which is especially troubling in that the compound which applicants wish to elect for examination purposes does not fall within any of the four groups proposed by the Patent Office. In the telephone conversation, a six-way

restriction requirement was proposed on behalf of applicants and the Examiner agreed to consider applicants' proposal made in response to the restriction requirement.

The six groups proposed by applicants are as follows:

1. V is O or S; A¹-A⁴ do not contain a ring; all other variables are as recited.
2. V is O or S; A¹-A⁴ contain a carbon ring; all other variables are as recited.
3. V is O or S; A¹-A⁴ contain a heterocycle ring; all other variables are as recited.
4. V is -CH₂-, -CH=CH- or -C≡C-; A¹-A⁴ do not contain a ring; all other variables are as recited.
5. V is -CH₂-, -CH=CH- or -C≡C-; A¹-A⁴ contain a carbon ring; all other variables are as recited.
6. V is -CH₂-, -CH=CH- or -C≡C-; A¹-A⁴ contain a heterocycle a ring; all other variables are as recited.

If the Patent Office were to accept these six groups, then applicants would choose the compound trans-methyl-{4-[5-(methyl-propyl-amino-)-pent-ynyl]-cyclohexyl}-carbamic acid 4-chloro-phenyl ester. This compound is the subject of Example 44.3 and falls within applicants' proposed Group 4. This compound falls within no group proposed by the Patent Office.

Applicants look forward to a response from the Patent Office. Once the Patent Office makes a restriction requirement that provides a group of compounds that include the selected compound, then applicants will be in a position to determine whether they

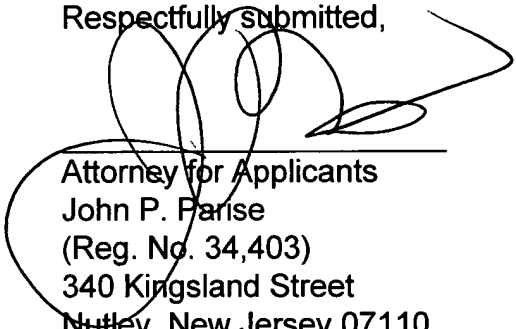
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will traverse the requirement. Applicants expressly reserve the right to traverse the restriction requirement once presented.

If a telephone conference would be of assistance in furthering prosecution, applicants request that the undersigned attorney be contacted at the number below.

No fee, other than the fee for a two-month extension of time, is required in connection with the filing of this Communication. If any fees are deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



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